Remarks

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing Amendment, claims 1-30 are pending in the application, of which claims 1, 10, 18, 25, and 29 are independent. By the foregoing Amendment, claims 1, 6, 7, 10, 15, 18, 22, 25, and 29 are sought to be amended. Claims 5, 14, and 21 are sought to be cancelled without prejudice or disclaimer. No new matter is embraced by this amendment and its entry is respectfully requested. Based on the above Amendment and the remarks set forth below, it is respectfully requested that the Examiner reconsider and withdraw all outstanding objections and rejections.

Rejection under 35 U.S.C. § 112

The Examiner, on page 2 of the Office Action, has rejected claims 5-7, 14-15, and 21-22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner states that the above claims contain subject matter that was not described in the specification. Applicants respectfully disagree.

With respect to claims 5, 14, and 21, the Examiner states that the disclosure does not show support for the limitation "recognized only if the command mark is placed in a specified area of the medium." Applicants respectfully disagree. Based on the remarks set forth below, Applicants respectfully request that this rejection be withdrawn.

Claims 5, 14, and 21 have been cancelled without prejudice or disclaimer. Claims 1, 10, and 18 have been amended to include the limitation recited in cancelled claims 5, 14, and 21. Support for this limitation is stated in the disclosure on page 5, lines 4-7 and page 5, lines 19-23.

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With respect to claims 6 and 15, the Examiner states that the disclosure does not show support for the limitation "first command mark must be recognized before any other command marks are recognized as executable commands." Applicants respectfully disagree. Support for claims 6 and 15 is found in the disclosure on page 4, line 10 – page 5, line 7.

With regards to claims 7 and 22, the Examiner states that the disclosure does not show support for the limitation "the medium includes printed text, and wherein the recognized command mark is executed to affect the printed text." Applicants respectfully disagree. Support for claims 7 and 22 is found in the disclosure on page 3, lines 8-11; page 3, line 22 – page 4, line 9.

Applicants respectfully request that the Examiner, after reviewing the specific locations stated above in the disclosure, withdraw this rejection.

Claim Objections

The Examiner, on page 2 of the Office Action, has objected to claims 5-7, 14-15, and 21-22 as being difficult to understand due to the use of confusing language. Applicants have cancelled claims 5, 14, and 21. Applicants have amended claims 6, 7, 15, and 22 to overcome this objection. Applicants respectfully request that the Examiner review these claims and withdraw this objection.

Rejection under 35 U.S.C. § 102

The Examiner, on page 2 of the Office Action, has rejected claims 1-3, 5-12, and 14-30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,897,648 to Henderson. Applicants respectfully traverse this rejection. Based on the remarks set forth below, Applicants respectfully request that this rejection be reconsidered and withdrawn.

To anticipate a claim of a pending application, a single reference must disclose each and every element of the claimed invention. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1397 (Fed. Cir. 1986). The exclusion of a claimed element from the single source is enough to negate anticipation by that reference. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1574 (Fed. Cir. 1984).

With regard to independent claim 1, Henderson does not teach or suggest every element of Applicants' claimed invention. For example, Henderson does not teach or suggest Applicants' claimed element of: "recognizing the scanned command mark as a command that may be executed by a processor, wherein the command mark is recognized only if the command mark is placed on a specified area of the conventional medium."

The Examiner states that Henderson teaches "wherein the command mark is recognized only if the command mark is placed on a specified area of the convention medium" at column 6, lines 35-44. Applicants respectfully disagree. Unlike the present invention, Henderson teaches the use of a hand-held scanner and how a single accurate digital image of a document may be obtained by stitching together scanned data collected on multiple passes with the hand-held scanner. *Henderson*, col. 6, lines 35-44. Thus, unlike the present invention, which teaches that "the command mark is recognized only if

the command mark is placed on a specified area of the convention medium", Henderson teaches obtaining a digital image of a document by stitching together scanned data collected on multiple passes using a hand-held scanner.

Thus, for at least the foregoing reasons, Applicants respectfully submit that independent claim 1 and the claims that depend therefrom (claims 2-9) are not anticipated by Henderson. Independent claims 10, 18, 25, and 29 include similar language as that recited in claim 1. Thus, for at least the foregoing reasons, Applicants respectfully submit that independent claims 10, 18, 25, and 29, and the claims that depend therefrom (claims 11-17, 19-24, 26-28, and 30, respectively) are also not anticipated by Henderson. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of independent claims 1, 10, 18, 25, and 29, and the claims that depend therefrom respectively.

Rejection under 35 U.S.C. § 103

The Examiner, on page 5 of the Office Action, has rejected claims 4 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,897,648 to Henderson as applied to claim 2, and further in view of U.S. Patent No. 5,768,418 to Berman. Applicants respectfully traverse this rejection. Based on the remarks set forth below, Applicants respectfully request that this rejection be reconsidered and withdrawn.

Claims 4 and 13 depend from independent claims 1 and 10, and are patentable over Henderson for at least the reasons stated above. Furthermore, Berman does not teach or suggest the features missing from Henderson. Applicants therefore respectfully

request that the Examiner reconsider and withdraw the rejection of dependent claims 4

and 13.

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Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all currently outstanding objections and rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Response is respectfully requested.

Respectfully submitted,

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Dated: *April 18, 2005*

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